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26304 7590 10/14/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER WORJLOH, JALATEE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/771,937	Applicant(s) USUMI, MOTOHARU	
	Examiner Jalatee Worjloh	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed July 9, 2008 have been fully considered but they are not persuasive.
2. Applicant disagrees with the 112 rejection that states "the specification does not clearly link and associate the corresponding structure to the judging means" and directs the Examiner to page 5, lines 29-37 of the specification.

However, the citation does not identify the "judging means"; that is, it merely states that "the billing server 6 further comprises a judging means 62 for judging, based on the result of the monitoring from the subscriber serving apparatus 2, the billing conditions for the user to whom the service is provided.". It is understood that the "judging means" is a component of the billing server, but what is this component? Is it software, hardware, or combination of both? Also, is the billing conditions only software? What is the algorithm associated with determining the billing conditions for the user?

3. Applicant asserts that the algorithm used by the judging means as expressed in page 5, lines 26-27 and page 7, lines 14-36.
4. According to Applicant's specification, "if the desired delivery quality is not satisfied, the user will not be billed for the provided service". The "judging means (element 63) determines, based on the result of that monitoring whether the benchmark for the quality parameters has been met. In the example above, packet arrival rate is the quality parameter and the benchmark is 100%".

The Examiner will like to note that Applicant labels the judging means as element 62 in one section of the specification (see page 5) and element 63 in another (see page 7). Which element is referring to the judging means “62” or “63”.

Also, the phrase "if the desired delivery quality is not satisfied" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear how the user's satisfaction is determined.

As for the algorithm, Applicant asserts that the specification provides an example of an algorithm for making the judging determination. However, if it is based on the satisfaction of the user, which is indefinite, then the presumed algorithm is also indefinite. “A rejection under 35 U.S.C. 112, second paragraph, is appropriate if the written description of the specification discloses no corresponding algorithm.” *See Aristocrat*, 521 F. 3d at 1337-38, 86 USPQ2d at 1243.

5. Applicant asserts that “more advanced algorithms for determination of whether the bill or not are discussed through the use of the billing judgment table 64, part of the judging means 63, described with reference to the embodiment shown in Fig. 6”.

However, the judgment table is described in dependent claims 5 and 9. According to the Declarant of Claim Differentiation, dependent claims are not part of the parent claim. Thus, it does not support Applicants statement.

6. Applicant states that the Examiner’s Office Action contains a mistake by referring to the judging means as element 63, not element 62. However, according to Applicant's specification the judging means is element 62 (see page 5, line 34).

7. Applicant argues that paragraph 9 of the office action the Examiner combines the statutory requirement of paragraphs first, second and sixth paragraphs. However, this section only addresses the second and sixth paragraphs.

8. Applicant argues that “One of skill in the art would understand that software, hardware, or a combination of both could be used to achieve this function on a server such as the subscriber serving apparatus.” However, this is insufficient. The phrase the fact that it either software, hardware or a combination of both "could be" does not clearly indicate what is being utilized. "A bare statement that known techniques or methods can be used would not be a sufficient disclosure” *See In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc); and *Biomedino, LLC v. Waters Technology Corp.*, 490 F.3d 946, 952, 83 USPQ2d 1118, 1123 (Fed. Cir. 2007).

9. Applicant argues that Walter teaches in paragraph [0045] billing based on a selected quality of service for the wireless device to transmit and receives packets. Based on this election the system allocates greater network resources to serve such connections. Applicant argues that Walker does not disclose actually monitoring the quality data received by the device and based on this actually received quality of data bases the billing determination.

However, the Examiner respectfully disagrees. Walter describes the monitoring a series of events, which is accomplished by a data rating application that resides on the wireless device. The rating method selected includes how to meter the data transmitted during a data a communication session and determine the rate to apply to each metered increment. The quality of service is a method used to meter the data (see abstract, paragraphs [0010], [0021]-[0023]). As for paragraph [0045] the data rating application bills the data communication based on the

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quality of service a user chooses for the wireless device to transmit and receive data packets. If the user selects low quality he is billed for such quality and also what is actually received ("the receive data packets". Paragraph [0046] of Walter states that "the data rating application calculates charges for the data communication session based on *the successful delivery and/or receipt of data packets by the wireless device*"... " Based on this determination, the data rating application works in conjunction with other accounting application *to credit an account to reflect the poor quality of service received during the data communication session.*" So, even if the user selects a particular quality of data, if the data packets are not received or received in poor quality the user will not be charged. Notice, the user is credited for poor quality of service received.

Specification

10. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and MPEP §2181 IV. and its discussion of 37 C.F.R. §1.75(d). The specification is replete with these errors. Some examples follow:

- i. The "judging means for judging . . ." as recited in at least claims 1 and 2.
- ii. The "monitoring means for monitoring . . ." as recited in at least claim 2.
- iii. The "means for identifying . . ." as recited in at least claim 3.

Claim Rejections - 35 USC §112 2nd Paragraph

11. Claims 1-10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

b. As per claims 1, 2, 5, 6, 9, and 10, the specification does not clearly link and associate the corresponding structure to the "judging means for judging the amount of billing to be charged to a user based on delivery quality of the monitored data stream at the subscriber serving apparatus" If Applicants intend the claimed "judging means . . ." to be software or a combination of hardware and software, the claims are indefinite because Applicant has not set forth any specific algorithm for performing the recited function. In particular, is the "judging means for judging" hardware, software, or a combination of both? Whatever the structure, where is this 'structure' linked as 'corresponding structure' within the original specification?

c. Also, in claims 1-4, 7 and 8, the specification does not clearly link and associate the corresponding structure to the "monitoring means for monitoring a data stream being delivered from the delivery server to the user terminal"

12. In Applicant's 2nd Appeal Brief under the section titled Summary of Claimed Subject Matter (beginning on page 2 of 2nd Appeal Brief), Applicant identifies the "judging means" (on page 3, last paragraph of the 2nd Appeal Brief) as "page 5, lines 34-37, Fig. 2 element 62"

13. A review of the original specification and the pages, lines, and figures designated by Applicant in the 2nd Appeal Brief shows that *e.g.*, the corresponding structure of the claimed

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"judging means" in the specification is simply "judging means." This amounts to purely functional claiming and is impermissible.

14. Additionally, a review of figure 2 element 62 shows that the claimed "judging means" is a 'BILLING DB.' Because Applicant has designated the claimed "judging means" as 'BILLING DB,' the claim is indefinite because it is unclear how the function of ¹ "judging the amount of billing to be charged to a user based on delivery quality of the monitored data stream at the subscriber serving apparatus" is performed in its entirety by a so called 'billing database.' "It remains true, of course, that corresponding structure need not include all things necessary to enable the claimed invention to work. It is equally true, however, that corresponding structure *must* include *all structure* that actually performs the recited function. [Emphasis added.]"

Cardiac Pacemakers Inc. v. St. Jude Medical Inc., 296 F.3d 1106, 1119, 63 USPQ2d 1725, 1734 (Fed. Cir. 2002) (citations omitted). As noted above, it is the Examiner's factual determination that even if the billing database is structure, it can not perform the recited function of "judging the amount of billing to be charged to a user based on delivery quality of the monitored data stream at the subscriber serving apparatus" since (at the very least), a 'bill,' a 'CPU,' and 'a data stream' would also be required.

15. Applicant is reminded, "For claim clauses containing functional limitations in 'means for' terms pursuant to §112 ¶ 6, the claimed function and its supporting structure in the specification must be presented with sufficient particularity to satisfy the requirements of §112 ¶

2. *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001)

¹ Applicant is reminded that "[t]he function of a means-plus-function limitation, however, must come from the claim language itself." *Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1258, 52 USPQ2d 1258, 1263 (Fed. Cir. 1999).

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(citations omitted). In other words, "[f]ailure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2." *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1380 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing *In re Dossel*, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997)).

16. To reiterate, it is the Examiner's position that merely stating that a "judging means" or "monitoring means" is the corresponding structure is--without more--not sufficient. Also, the specification contains no step-by-step process for performing the claimed functions of "judging means for judging the amount of billing to be charged to a user based on delivery quality of the monitored data stream at the subscriber serving apparatus or monitoring means for monitoring a data stream being delivered from the delivery server to the user terminal." For an applicant to claim a "means for judging" or "means for monitoring" a particular function and then to disclose only a general purpose computer (or general purpose database) as the structure designed to perform that function amounts to pure functional claiming.

17. To be clear, Applicant is *not* required to produce a listing of source code or a highly detail description of the algorithm to be used to achieve the claimed functions in order to satisfy 35 U.S.C. §112, 6th paragraph. However, if software is part of the corresponding structure, Applicant is *required* to at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the disclosed algorithm.

18. Finally, Applicant is reminded that when complying with the above requirements, no new matter is allowed.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1- 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent No. 200027030 to Kei ("Kei") in view of U.S. Publication NO. 2002/0177429 to Walter et al. ("Walter").

21. Referring to claim 1, Kei discloses a subscriber (i.e. user terminal) serving apparatus serving a user, a delivery server for delivering content (i.e. contents distribution module), a billing server for billing the delivery of the content (i.e. accounting means) (see abstract and paragraph [0008]), the subscriber serving apparatus includes monitoring means (see paragraph [0009] – in a user terminal, an information storage means accumulates the information about the receiving quality of said contents) and the billing server includes judging means (i.e. decision means). Kei does not expressly disclose judging the amount of billing to be charged to a user based on delivery quality of the monitored data stream at the subscriber serving apparatus, and bills the user on the result of the judgment made by the judging means. Walter discloses judging the amount of billing to be charged to a user based on delivery quality of monitored data stream at the subscriber serving apparatus, and bills the user on the result of the judgment made (see *abstract* – the rating method selected includes both how to meter the data transmitted during a data communication session and determine the rate to be applied to. Different rating methods which can be used to rate the communication session includes quality of service and transmission

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efficiency, *paragraphs [0010], [0021]-[0023]* - the monitoring of such events is accomplished by the data rating application that resides in the wireless device. The data rating application is then able to determine when to evaluate the factors needed to determine how to rate the data communication session as well as, when to begin, and when to end, metering the data communication session. The data rating application is then able to apply the applicable rate to the metered data and *paragraph [0045]* and *claim 1*). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system of Kei to include judging means that judges the amount of billing to be charged to a user based on delivery quality of the monitored data stream at the subscriber serving apparatus, and bills the user based on the result of the judgment made by the judging means. One of ordinary skill in the art would have been motivated to do this because it eliminates the loss of packet and data quality of streamed content that normally occurs when there is a system overload (see *paragraph [0006]* of Kei).

22. Additionally, functional recitation(s) using the word “for” or other functional language have been considered but are given little patentable weight² because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine

² See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

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itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115.

Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

23. Claim 2 is rejected on the same rationale as claim 1 above.

24. Referring to claim 3, Kei discloses the delivery server includes means for identifying the subscriber serving apparatus serving the user terminal that originated a delivery request (see paragraph [0033] – the contents distribution module searches the contents database based on the user ID and password), and for sending information specifying the user terminal and the data stream to be monitored to the subscriber serving apparatus (see paragraph [0045]) and the subscriber serving apparatus, based on the information received from the delivery server, identifies the user terminal and the data stream to be monitored by the monitoring means (see paragraph [0046]).

25. Claims 4, 7 and 8 are rejected on the same rationale as claim 3 above.

26. Referring to claim 5, Kei discloses judging means (see claim 1 above). Kei does not expressly disclose the judging means includes a billing judgment table for setting billing parameter, and determines the amount of billing to be charged to the user, based on the result of the judgment of the delivery quality of the monitored data stream and the billing. Walter discloses a billing judgment table (rating table) for setting billing parameter (different rate information), and determines the amount of billing to be charged to the user, based on the result of the judgment of the delivery quality of the monitored data stream and the billing (see paragraph [0038]). At the time the invention was made, it would have been obvious to a person

although all limitations must be considered, not all limitations are entitled to patentable weight).

of ordinary skill in the art to modify the system disclose by Kei to include a billing judgment table for setting billing parameter, and determines the amount of billing to be charged to the user, based on the result of the judgment of the delivery quality of the monitored data stream and the billing. One of ordinary skill in the art would have been motivated to do this because it assist in determining the appropriate bill for the type of content quality distributed.

27. As per claims 6 and 10, Kei discloses judging means (see claim 1 above). Kei does not expressly disclose the judging means judges whether to bill or not bill the user based on the delivery quality of the monitored data stream at the subscriber serving apparatus. Walter teaches judging means that judges whether to bill or not bill the user based on the delivery quality of the monitored data stream at the subscriber serving apparatus (see paragraph [0012] – upon initiating one of the number of rating method [including quality of service], causing the data rating application to calculate charges for the data communication session based on the initiated rating method). Thus, in calculating the charges for the rating method, which includes the quality of service, the data application is determining "whether to bill or not bill". This is also an inherent feature; that is, if it is determined that the cost is zero then the user will not be charged (i.e. "not bill") otherwise the user will be billed. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the judging means disclose by Kei to judge whether to bill or not bill the user based on the delivery quality of the monitored data stream at the subscriber serving apparatus. One of ordinary skill in the art would have been motivated to do this because it eliminates the loss of packet and data quality of streamed content that normally occurs when there is a system overload (see paragraph [0006] of Kei).

28. Claim 9 is rejected on the same rationale as claim 5 above.

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29. With respect to claims 1-10, the Examiner respectfully reminds Applicant that: “A system is an apparatus.” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). Additionally, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner’s position that Applicant’s “system” claims are “product,” “apparatus,” or more specifically, “machine” claims.³

30. In light of Applicant's choice to pursue machine claims as noted above, Applicant is also reminded that functional recitations using the word “for” only (*i.e.* this does *not* include “means for” phrase since “means for” phrases are interpreted in accordance with 35 U.S.C. §112 6th paragraph), “adapted to,” or other functional terms (*e.g.* see claim 1 which recites “for delivering content over a network”) have been considered but are given little patentable weight⁴ because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use in a product claim must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re*

³ Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a).

⁴ See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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Otto, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner and except for claim phrases that successfully invoke 35 U.S.C. §112 6th paragraph, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

31. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant to be his own lexicographer and to define a claim term to have a meaning other than its ordinary and accustomed meaning. Therefore, the Examiner starts with the heavy presumption that all claim limitations (except for those limitations that successfully invoke 35 U.S.C. §112 6th paragraph) are given their ordinary and accustomed meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).⁵

In accordance with the ordinary and accustomed meaning presumption, during examination the claims are interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also MPEP §2111.

⁵ It is the Examiner’s position that “plain meaning” and “ordinary and accustomed meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

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However, if Applicant disagrees with the Examiner and has either (a) already used lexicography or (b) wishes to use lexicography and therefore (under either (a) or (b)) desires a claim limitation to have a meaning other than its ordinary and accustomed meaning, the Examiner respectfully requests Applicant in his next response to expressly indicate⁶ the claim limitation at issue and to show where in the original specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the original specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).⁷ The Examiner cautions that no new matter is allowed.

⁶ “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]” *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

⁷ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.01, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

Applicant is reminded that failure by Applicant in his next response to properly traverse this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant to forgo lexicography in this application and to continue having the claims interpreted with their broadest reasonable interpretation.⁸ Additionally, it is the Examiner's position that the above requirements are reasonable.⁹ Unless expressly noted otherwise by the Examiner and except for claim phrases that successfully invoke 35 U.S.C. §112 6th paragraph, the preceding discussion on claim interpretation principles applies to all examined claims currently pending.

32. To the extent that the Examiner's interpretations are in dispute with Applicant's interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all her claim interpretations.¹⁰ Moreover, while the following list is provided in accordance with *In re Morris*, the definitions are a guide to claim

⁸ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

⁹ The Examiner's requirements on this matter are reasonable on at least two separate and independent grounds. First, the Examiner's requirements are simply an express request for clarification of how Applicant intends his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant is not inadvertently overlooked by the Examiner. Second, the requirements are reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, available at www.uspto.gov/web/offices/com/strat2007/stratplan2007-2012.pdf (last accessed April 25, 2008).

¹⁰ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

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terminology since claim terms must be interpreted in context of the surrounding claim

language.¹¹ Finally, the following list is not intended to be exhaustive in any way:

Server: “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press,

Redmond, WA, 1997.¹² **Client:** “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a server).” *Id.*

Computer: “Any machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” *Id.*

Database “A file composed of records, each containing fields together with a set of operations for searching, sorting, recombining and other functions.” *Id.*

Relational Database “A database or database management system that stores information in tables—rows and columns of data—and conducts searches by using data in specified columns of one table to find additional data in another table. In a relational database, the rows of a table represent records (collections of information about separate items) and the columns represent fields (particular attributes of a record). In conducting

¹¹ See e.g. *Brookhill-Wilk 1 LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (abstract dictionary definitions are not alone determinative; “resort must always be made to the surrounding text of the claims in question”).

¹² Based upon Applicant’s disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled ‘New Terminology.’

searches, a relational database matches information from a field in one table with information in a corresponding field of another table to produce a third table that combines requested data from both tables. . . . Microcomputer database products typically are relational databases. *Compare* flat-file database, inverted-list database.” *Id.*

33. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is general knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these three references are directed towards beginners (see e.g. “User Level Beginning . . .”), because of the references’ basic content (which is self-evident upon review of the references), and after further review of the entire application and all the art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these three references are primarily directed towards those of low skill in this art. Because these three references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within these three references.

34. Applicant is reminded that patents are written by and for skilled artisans. See e.g. *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”).¹³ The Examiner

¹³ See also *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1371, 59 USPQ2d 1745, 1749-50 (Fed. Cir. 2001)(“patents are written for persons experienced in the field of the invention”).

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therefore starts with the presumption that Applicant is a skilled artisan who possess at least ordinary skill in the art. Consequently, it is the Examiner's position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicant is hereby given actual notice that if after reasonably reading any reference of record—whether the reference is currently of record or subsequently made of record—if Applicant can not reasonably understand or if Applicant has difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in the reference(s), Applicant should (in his next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicant's response must also state *why* he either does not understand or *why* he has difficulty comprehending the offending reference(s). If after properly receiving (*i.e.* Applicant's response is made of record) both Applicant's request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do her best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) in the offending reference. For all documents or references made of record after this Office Action, Applicant is given actual notice that this paragraph becomes effective when Applicant receives notice that the document or reference is made of record (*i.e.*

this paragraph becomes applicable when Applicant submits an Information Disclosure Statement or when Applicant receives an examiner's Notice of References Cited (Form PTO-892)).

35. Applicant is also reminded that it is inappropriate for the USPTO to disregard any relevant evidence of record. "It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983). Second, when making substantive patentability determinations, the USPTO uses the preponderance of the evidence standard.¹⁴ In light of this standard, it is clear error for the USPTO not to consider *all* evidence of record. See *e.g. In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) ("All the evidence on the question of obviousness must be considered."); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ("After evidence or argument is submitted by the applicant in response, patentability is determined on *the totality of the record*, by a preponderance of evidence with due consideration to persuasiveness of argument. [Emphasis added.]"); *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002) ("Patentability vel non is then determined on the *entirety* of the record, by a preponderance of evidence and weight of argument. . . . ; patentability is determined by a preponderance of *all* the evidence. [Emphasis added.]"); and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 146 (CCPA 1976) (where the court expressly set forth the issue as "Whether, in light of *all the evidence*, the claimed method would have been obvious at the time the invention was made. [Emphasis added.]"). Third, any factual determination by the USPTO that does not consider *all* relevant evidence of record may not be

¹⁴ See MPEP §706 I. "The standard to be applied in *all* cases is the 'preponderance of the evidence' test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable. [Emphasis added.]"

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supported by the required substantial evidence¹⁵ since the particular evidence *not* considered may be probative of a factual issue presented. Forth, prior art patents are not technical treatises and therefore these patents intentionally omit features that are known in the field of the invention. See *S3 Inc. v. nVIDIA Corp.*, 259 F.3d at 1371, 59 USPQ2d at 1749-50 (“The law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention. ... To hold otherwise would require every patent document to include a technical treatise for the unskilled reader.”); and *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999)(“The specification would be of enormous and unnecessary length if one had to literally reinvent and describe the wheel.”). Finally and perhaps most importantly, it is well established that “[a] reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. [Emphasis in original.]’” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous or parallel monitoring is

¹⁵ See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000) where the Federal Circuit concluded that USPTO’s factual findings must be supported by substantial evidence.

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within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at 1701.¹⁶ In conclusion, because, *inter alia*, it is inappropriate for the USPTO to disregard any relevant evidence, because the USPTO must consider all evidence of record, because any evidence of record *not* considered by the USPTO may be probative of at least one factual issue presented, and because anticipation (and/or obviousness) is determined by the teachings of a reference in combination with the knowledge of one of ordinary skill in the art, Applicant is hereby given actual notice that all prior art rejections (*i.e.* rejection(s) based upon 35 U.S.C. §§ 102 or 103)—if found in this Office Action or any subsequent office action—are based upon the cited reference(s) in the statement of the rejection in combination with the knowledge of one of ordinary skill in this art.

Conclusion

36. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

¹⁶ See also *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) for the same

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and 571-273-6714 for Non-Official /Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/
Primary Examiner, Art Unit 3685